

REMARKS***Summary of the Response***

By the present response, claim 30 has been amended to more clearly recite features of the present invention. Applicants submit that no new matter is added by the present amendment. Support for the amendment may be found, for example, at least in paragraphs [0039] and [0055] (as numbered in published application 2007/0160710). Accordingly, upon entry of the amendment, claims 30 – 62 will remain pending. Reconsideration of the rejected claims in view of the above amendment and following remarks is respectfully requested.

Summary of the Office Action

In the instant Office Action, the Examiner has rejected claims 30 – 62 over the art of record. By the present remarks, Applicants submit that the rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Traversal of Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Applicants traverse the rejection of claims 38, 39 and 55 under 35 U.S.C. § 112, 2nd paragraph as being indefinite. Initially, Applicants note that, while claim 39 is listed in the 35 U.S.C. § 112, 2nd paragraph rejection, the Examiner failed to discuss claim 39 and gives no basis for an indefiniteness rejection. Additionally, Applicants note claim 39 does not depend on claim 38 or 55, and thus is not rejected based on the rejections of claims 38 or 55. As such, Applicants assume claim 39 was not intended to be rejected under 35 U.S.C. § 112, 2nd paragraph.

Turning to claims 38 and 55, the Examiner asserts that with regard to claim 38, the phrase "when viewed from above" is vague and indefinite; and with regard to claim 55, the phrase "when viewed from above in a displacement direction" is vague and indefinite. The Examiner states "from above is not tied to any structure." Additionally, with regard to claim 55, the Examiner asserts the phrase "in a displacement direction" is not understood and fails to limit the claim. Applicants respectfully disagree.

According to MPEP 2173.02, the test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Moreover, definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

The instant specification states, for example, at paragraph [0055] (as numbered in published application 2007/0160710) that (emphasis added):

The steeping cistern 1 functions as follows: Starting from an unfilled state of the container 2, the barley 5 is introduced into the container 2. Water is then supplied via the water line system to the barley 5 through the passageways 6, so that the barley 5 is completely immersed in the water. This state of the wet steeping phase is retained for several hours, for example two or three hours. Because the passageways 6 are arranged in radial rows 7 and separate air valves 23 that can be individually opened and closed by a control system (not shown in any greater detail) are used per row, it is possible during the wet steeping phase to selectively provide rows 7 with air during the rotation of the scraper body 30 in a rotational direction 33 directly preceding the scraper body 30 with viewed from above, so that dirt there floats up locally to more of an extent, and can be removed via the scraping wall 31 through the capstan 32.

In view of the above, Applicants respectfully submit that claims 38 and 55 are definite and clear. That is, Applicants respectfully submit that those skilled in the art would understand what is claimed by "when viewed from above" and "when viewed from above in a displacement direction" when the claims are read in light of the specification.

Accordingly, for at least these reasons, Applicants respectfully request the rejection of claims 38, 39 and 55 be withdrawn and the Examiner indicate that claims 38, 39 and 55 are in compliance with 35 U.S.C. § 112, 2nd paragraph.

Traversal of Rejection Under 35 U.S.C. § 102(b)

Applicants traverse the rejection of claims 30 - 33 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 12,204 to Hammer [hereinafter HAMMER]. The rejection is respectfully traversed.

To anticipate a claim, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. MPEP § 2131. Applicants submit that HAMMER does not disclose each of the features of the present invention.

Independent Claim 30

The present invention is directed to a method and device for steeping barley. In addressing previously presented claim 30, the Examiner asserts HAMMER discloses each of the features of previously presented claim 30. While Applicants do not agree with the Examiner that the applied art under 35 U.S.C. §102(b) anticipates the embodiments of the invention recited in at least claim 30, in an effort to advance prosecution, claim 30 has been amended to even more clearly define the features of the present invention. Further, Applicants expressly reserve the

right to refile the subject of independent claim 30 as presented prior to this amendment in one or more continuing applications.

Claim 30 recites, in pertinent part:

. . . a container structured and arranged for steeping barley having
a floor structured and arranged for supporting the barley;
passageways arranged in the floor for at least one of steeping water
and gases to pass through; and
a water line system located under the floor and directly connected
to the passageways.

Applicants respectfully submit HAMMER does not disclose each of the features of claim 30. For example, Applicants submit HAMMER at least does not disclose: (1) a floor structured and arranged for supporting the barley; or (2) a water line system located under the floor and directly connected to the passageways, as recited in claim 30.

No Disclosure Of A Floor Structured And Arranged For Supporting The Barley

Applicants submit HAMMER fails to disclose a floor structured and arranged for supporting the barley. HAMMER discloses an apparatus for producing extract from hops. That is, in contrast to the present invention, which is directed to a device and method for steeping barley, HAMMER is directed to a completely different technological field (i.e., hop extraction). Moreover, Applicants note HAMMER provides no disclosure or teaching of using the HAMMER apparatus in other fields, such as, for example, steeping barely.

As shown in Figure 1, the HAMMER apparatus includes a cylindrical retaining vessel A (i.e., a receiver and a cover), which when in operation is placed within a boiling vessel B. More specifically, in operation, hops are placed into the retaining vessel A, the cover of the vessel A is placed on the receiver, and the retaining vessel is placed into the boiling vessel B atop cross pieces k. As further explained in HAMMER, “the hole (i) in the bottom being closed by a tap

and faucets, or stop cock, the extracting fluid is now run into the boiling vessel (B), until it reaches within about (say) four inches of the diaphragm (d) of the cover of the retaining vessel (A) . . .”

In addressing claim 30, the Examiner designates the diaphragm d as the recited “floor,” and designates the tube e, which is arranged in the diaphragm, as the recited “passageway arranged in the floor.” As can be observed in Figure 1, however, Applicants submit, the diaphragm d forms a portion of the cover of the retaining vessel. As such, the diaphragm d cannot reasonably be construed as the recited “floor” of the present invention. Moreover, as the Examiner-designated floor (i.e., diaphragm d) is a cover of the retaining vessel and is not structured and arranged to support any materials thereon, Applicants respectfully submit the diaphragm d cannot reasonably be construed as the recited “floor structured and arranged for supporting the barley.”

Thus, for at least these reasons, Applicants submit HAMMER fails to disclose a floor structured and arranged for supporting the barley, as recited in claim 30.

No Disclosure Of A Water Line System Located Under The Floor And Directly Connected To The Passageways

Additionally, Applicants submit HAMMER fails to disclose a water line system located under the floor and directly connected to the passageways. In addressing previously presented claim 30, the Examiner asserts HAMMER discloses a “water line system located under the floor and directly connected to the passageways,” stating “Hammer discloses . . . passageways (e) (see col. 1, lines 47-48) arranged in the floor for at least one of steeping water and gases to pass

through via a water line system (B, d, e and "vent cock" as described in col. 3, line 10-25) located under the floor and directly connected to the passageways . . ."

With regard to the Examiner-designated water line system (i.e., elements B, d, e and "vent cock" as described in col. 3, line 10-25), Applicants submit that none of these elements can reasonably constitute the recited "water line system located under the floor and directly connected to the passageways." More specifically, Applicants submit element d (i.e., the diaphragm) cannot reasonably constitute the recited "water line system," as the Examiner has already designated element d as the recited "floor." Additionally, Applicants submit element e (i.e., the tube) cannot reasonably constitute the recited "water line system located under the floor and directly connected to the passageways," due to the fact that element d cannot reasonably constitute the recited floor, as discussed above. That is, as element d cannot reasonably constitute the recited floor, Applicants submit element e is not located "under the floor" as recited in claim 30.

Furthermore, Applicants submit the "vent cock" as described in col. 3, line 10-25 cannot reasonably constitute the recited "water line system." Applicants submit the vent cock (which is not illustrated) is located in the cover (i.e., the diaphragm d of the cover), "for the purpose of allowing the escape of atmospheric air as the fluid rises above the lower end of the tube (e) therein, which cock is closed when the fluid reaches the designated height in the retaining vessel (A) . . ." (See HAMMER, page 2, lines 11 - 17.) As such, Applicants submit the vent cock is cannot reasonably constitute a water line system, as the vent cock does not pass any water there through. Moreover, as the vent cock is located in the cover (i.e., the diaphragm d of the cover), Applicants submit the vent cock is not located under the Examiner-designated floor (i.e., diaphragm d) but instead is located in the Examiner-designated floor. As such, for at least these

reasons, Applicants submit the “vent cock” cannot reasonably constitute the recited “water line system.”

Additionally, Applicants submit that the boiling vessel B cannot reasonably constitute the recited water line system, as the boiling vessel does not include any water lines. As noted in HAMMER, extracting fluid is “run into the boiling vessel,” until it reaches within about four inches of the diaphragm d of the cover of the retaining vessel A. However, Applicants respectfully submit that HAMMER does not disclose any system for supplying the extracting fluid. From the HAMMER document, it appears the extracting fluid is merely poured in the boiling vessel B from the open top of the boiling vessel B (i.e., the same opening through which the retaining vessel A is placed into the boiling vessel B).

Thus, for at least these reasons, Applicants submit HAMMER fails to disclose a water line system located under the floor and directly connected to the passageways, as recited in claim 30.

Accordingly, for at least these reasons, Applicants respectfully submit that HAMMER fails disclose each of the features of the presently claimed invention, and fails to anticipate the presently claimed invention.

Dependent Claims 31 - 33

Applicant respectfully submits that claims 31 - 33 depend from distinguishable independent claim 30, and are allowable based upon the allowability of independent claim 30, and because these claims recite additional subject matter to further define the instant invention.

Claim 31

Applicants note that while claim 31 is indicated as rejected, the Examiner did not address any of the features of this claim. The Examiner is respectfully reminded of the guidance provided by MPEP § 707.07(f), which states:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Additionally, the Examiner is respectfully reminded of the guidance provided by MPEP § 2143.03, which states:

All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Applicants respectfully submit the rejection of claim 31 is *per se* improper and the Examiner has failed to provide a complete action and a clear record, as discussed further below.

Accordingly, for at least these reasons, Applicant respectfully requests the Examiner withdraw the rejection of claims 30 - 33 and indicate claims 30 - 33 are allowable.

Traversal of Rejections Under 35 U.S.C. § 103(a)

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP §2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings.¹ Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant submits that the reference, or combination of references, does not teach or suggest each of the features of the present invention and/or there is no reasonable expectation of success for the Examiner-proposed combinations.

1. Over HAMMER in view of SAUVAGE

Applicants traverse the rejection of claims 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over HAMMER in view of U.S. Patent No. 5,282,413 to Sauvage et al [hereinafter SAUVAGE]. The rejection is respectfully traversed.

Initially, Applicants submit claims 34 and 35 depend from allowable independent claim 30, and are allowable based upon the allowability of independent claim 30, and because these claims recite additional subject matter to further define the instant invention. Furthermore, Applicants submit SAUVAGE does not cure the above-noted deficiencies of HAMMER. For example, Applicants submit that SAUVAGE at least does not disclose a water line system located under the floor and directly connected to the passageways.

¹ While the KSR court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007)).

Additionally, Applicants submit that HAMMER in view of SAUVAGE does not teach or suggest the features of claims 34 and 35. In addressing claims 34 and 35, the Examiner asserts SAUVAGE teaches “passageways that are arranged in radially oriented rows (Fig. 4-5; 12), and as is shown, one is located at a variable position relative to the next one.” Applicants respectfully disagree.

Applicants submit that the Examiner-designated passageways (i.e., element 12) are not passageways at all. Instead, as explained in SAUVAGE, element 12 is a prop, a plurality of which are used to support the perforated platform while in operation. For example, see column 3, lines 51 – 56. As such, SAUVAGE does not teach or suggest passageways, as the Examiner asserts, let alone, passageways arranged in radially oriented rows, as recited in claim 34.

As such, Applicants submit no reasonable combination of these documents renders the invention of claims 34 and 35 unpatentable.

Additionally, with regard to claim 35, Applicants submit the Examiner did not address each of the features of this claim. For example, Applicants submit the Examiner never addressed (emphasis added) “adjacent radially oriented rows having varied lengths.”

The Examiner is respectfully reminded of the guidance provided by MPEP § 707.07(f) and MPEP § 2143.03, which are set forth above. Applicants respectfully submit the rejection of claim 35 is *per se* improper and the Examiner has failed to provide a complete action and a clear record, as discussed further below.

Accordingly, for at least these reasons, Applicants respectfully request the Examiner withdraw the rejection of claims 34 and 35, and indicate claims 34 and 35 are allowable.

2. Over HAMMER in view of SCHULTZ

Applicants traverse the rejection of claims 36 - 40², 48 - 57 and 61 under 35 U.S.C. § 103(a) as being unpatentable over HAMMER in view of U.S. Patent No. 3,730,845 to Schultz [hereinafter SCHULTZ]. The rejection is respectfully traversed.

Initially, Applicants submit claims 36 - 40, 48 - 57 and 61 depend from allowable independent claim 30, and are allowable based upon the allowability of independent claim 30, and because these claims recite additional subject matter to further define the instant invention.

Moreover, Applicants submit the Examiner's combination of HAMMER and SCHULTZ would not be obvious to one of ordinary skill in the art, as these two devices operate in significantly different manners, such that there would be no reasonable expectation of success with the Examiner-proposed combination. In asserting the purported obviousness of the combination, the Examiner states “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modernize the multiple passageways disclosed by Hammer (see col. 1, lines 47 - 50) by incorporating a shared, branch and main water line elements as well as a cleaning system as disclosed by Schultz for efficient introduction and evacuation of seeping [sic] water and the ability to systematically clean the device.” Additionally, the Examiner states “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modernize air system disclosed by Hammer by incorporating a shared, branch and main air line elements which are attached and coupled to the passageways leading to the container and regulated by air valves in order to uniformly control the air ratio and quantity and a scrapper

² Applicants note that the statement of rejection indicates claims 36 - 39, 48 - 57 and 61 are rejected over the prior art. However, claim 40 is also addressed in this rejection. As such, Applicants assume the Examiner intended to reject claim 40, and address the Office Action accordingly.
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system that can be raised or lowered to reach the water level as disclosed by Schultz." Applicants disagree.

With regard to the Examiner's statement that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modernize the multiple passageways disclosed by Hammer (see col. 1, lines 47 - 50)," Applicants respectfully submit that the Examiner-designated passageways (i.e., the tube (e), which is merely a passage through the lid of the retaining vessel A) would not benefit from shared, branch and main water line elements, as purportedly disclosed by SCHULTZ. That is, as the Examiner-designated passageway (i.e., the tube (e)) is merely a passage from an interior of the retaining vessel (A) to the exterior of the retaining vessel (A) and is not used to supply water to or remove water from the SCHULTZ apparatus, Applicants submit that there is no reasonable expectation of success for the Examiner-proposed combination, which requires replacing the tube (e) of HAMMER with shared, branch and main water line elements, as purportedly disclosed by SCHULTZ.

Moreover, with regard to the Examiner's statement that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modernize air system disclosed by Hammer by incorporating a shared, branch and main air line elements which are attached and coupled to the passageways leading to the container and regulated by air valves in order to uniformly control the air ratio and quantity," Applicants respectfully submit that HAMMER does include an air system, contrary to the Examiner's assertion. Applicants note, while asserting its existence, the Examiner has not positively identified any air system in HAMMER. As such, Applicants submit there would be no reasonable expectation of success for the Examiner-proposed combination.

As such, for at least these reasons, Applicants respectfully submit that it would not have been obvious to combine these documents in the manner asserted, and that no reasonable combination of these documents can render the presently claimed invention unpatentable.

Claim 37

Additionally, with regard to claim 37, Applicants submit the Examiner did not address any of the features of this claim. The Examiner is respectfully reminded of the guidance provided by MPEP § 707.07(f) and MPEP § 2143.03, which are set forth above. Applicants respectfully submit the rejection of claim 37 is *per se* improper and the Examiner has failed to provide a complete action and a clear record, as discussed further below.

Claims 54 and 55

Additionally, Applicants submit that HAMMER in view of SCHULTZ does not teach or suggest each of the features of claims 54 and 55. Claim 54 recites, in pertinent part:

. . . the container further comprises:
 a scraper body, positionable near an upper side of the container,
 structured and arranged to shift in a displacement direction along a surface
 of the water to one of scrape and collect elements circulating on a surface
 of the water.

Claim 55 recites, in pertinent part:

. . . as the scraper body shifts in a displacement direction along the
 surface of the water, the control system opens at least one of the air valves
 directly preceding a front side of the scraper body when viewed from
 above in the displacement direction.

In addressing claims 54 and 55, the Examiner states "Schultz discloses . . . a scrapper body (col. 5, line 49), positionable near an upper side of the container (col. 5, line 49 - 50),
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structured and arranged to shift (col. 5, lines 59 - 69) direction over the surface of the water in a displacement direction along the surface of the water (col. 5, lines 33 - 37) to one of scrape and collect elements circulating on the surface of the water, the control system opens at least one of the air valves (col. 5, lines 40 - 43) directly preceding a front side of the scrapper body when viewed from above in the displacement direction . . ." Applicants respectfully disagree.

While acknowledging that SCHULTZ discusses a "scrapper," stating at column 5, line 48, "[h]owever, in addition to the described manner, the malting material can also be introduced simply by gravity feed, either dry or with water, in uniform distribution through the coupling 19 and can be evacuated through a manhole arranged in the bottom of the box by means of a scrapper arranged for lowering movement underneath the lid 9," Applicants submit SCHULTZ provides no teaching or suggestion of a scrapper body as recited in claim 54. That is, for example, the Examiner-designated scrapper is arranged to remove material through a manhole arranged in the bottom of the box. As such, Applicants submit the Examiner-designated scrapper of SCHULTZ is at least not structured and arranged to shift in a displacement direction along a surface of the water to one of scrape and collect elements circulating on a surface of the water, as recited in claim 54.

With regard to claim 55, contrary to the Examiner's assertions, Applicants submit SCHULTZ does not provide any teaching or suggestion that as the scrapper body shifts in a displacement direction along the surface of the water, the control system opens at least one of the air valves directly preceding a front side of the scrapper body when viewed from above in the displacement direction. The Examiner-cited passage of SCHULTZ merely describes the pneumatic conveyor unit for evacuating of the malt, which also notes that the pneumatic conveyor unit may also be used to introduce malting material into the box. Applicants submit

SCHULTZ is completely silent as to the scraper body shifting in a displacement direction along the surface of the water, the control system opening at least one of the air valves directly preceding a front side of the scraper body when viewed from above in the displacement direction.

As such, for at least these reasons, Applicants submit that no reasonable combination of HAMMER and SCHULTZ teaches or suggests the features of claims 54 and 55.

Claim 61

Applicants note that while claim 61 is indicated as rejected, the Examiner did not address any of the features of this claim. The Examiner is respectfully reminded of the guidance provided by MPEP § 707.07(f) and MPEP § 2143.03, which are set forth above. Applicants respectfully submit the rejection of claim 61 is *per se* improper and the Examiner has failed to provide a complete action and a clear record, as discussed further below.

Accordingly, for at least these reasons, Applicants respectfully request the Examiner withdraw the rejection of claims 36 - 40, 48 - 57 and 61, and indicate claims 36 - 40, 48 - 57 and 61 are allowable.

3. Over HAMMER in view of SCHULTZ and further in view of DEBLOIS and NUMBERGER

Applicants traverse the rejection of claims 41 – 47, 60 and 62 under 35 U.S.C. § 103(a) as being unpatentable over HAMMER in view of SCHULTZ, and further in view of U.S. Patent Publication No. 2005/0037452 to Deblois et al. [hereinafter DEBLOIS] and U.S. Patent No. 4,048,019 to Numberger [hereinafter NUMBERGER]. The rejection is respectfully traversed.

Dependent Claims 41 – 47 and 60

Initially, Applicants submit claims 41 – 47 and 60 depend from allowable independent claim 30, and are allowable based upon the allowability of independent claim 30, and because these claims recite additional subject matter to further define the instant invention.

All Features Not Addressed

Applicants note that while claims 42 - 47 and 60 are indicated as rejected, the Examiner did not address any of the features of these claims. The Examiner is respectfully reminded of the guidance provided by MPEP § 707.07(f) and MPEP § 2143.03, which are set forth above. Applicants respectfully submit the rejection of claims 42 - 47 and 60 are *per se* improper and the Examiner has failed to provide a complete action and a clear record, as discussed further below.

SCHULTZ Teaches Away from Examiner-Proposed Combination

Additionally, Applicants submit that SCHULTZ teaches away from the Examiner-proposed combination. Claim 41 recites, in pertinent part:

... a CO₂ line system located under the floor being connected directly to the passageways for removing CO₂ from the container.

In addressing claim 41 (from which claims 42 - 47 and 60 depend), the Examiner acknowledges that HAMMER does not disclose extracting CO₂. Additionally, the Examiner acknowledges that SCHULTZ does not disclose “that specifically CO₂ should be removed.” However, the Examiner asserts NUMBERGER discloses that CO₂ should be removed, and that it would have been obvious to combine HAMMER, SCHULTZ, NUMBERGER and DEBLOIS

"to extract CO₂ to control the germination process as disclosed by [NUMBERGER]." Applicants respectfully disagree.

Applicants submit SCHULTZ teaches away from such a modification. That is, modifying SCHULTZ as the Examiner asserts would render SCHULTZ unsuitable for its intended purpose. Applicants note that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Applicants note that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, Applicants note that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicants submit modifying HAMMER in view of SCHULTZ in the manner asserted by the Examiner (i.e., by combining with NUMBERGER) would render SCHULTZ unsatisfactory for its intended purpose. Applicants note that the Examiner's statement that SCHULTZ does not disclose "that specifically CO₂ should be removed," is misleading, in that SCHULTZ explicitly discloses that the CO₂ should not be removed and that high and uniform carbon dioxide concentrations are desirable. That is, in discussing the prior art, SCHULTZ states at column 2, lines 64 - 69 that, "[t]he large box volume both below the kiln floor and above the malting material is also disadvantageous with regard to the use of carbon-dioxide containing flooring air, because it is impossible to achieve high and uniform CO₂ content within the flooring air."

Additionally, in discussing the SCHULTZ apparatus, SCHULTZ states at column 4, lines 56 - 58 that, “[t]he small enclosed air volume makes possible high and uniform carbon dioxide concentrations during circulating operation.”

As such, Applicants submit modifying HAMMER in view of SCHULTZ in the manner asserted by the Examiner (i.e., by combining with NUMBERGER) would render SCHULTZ unsatisfactory for its intended purpose. Thus, Applicants submit SCHULTZ teaches away from the Examiner-proposed modification, in that the Examiner-proposed modification would render SCHULTZ (or HAMMER in view of SCHULTZ) unsatisfactory for its intended purpose. Thus, Applicants submit there is no suggestion or motivation to make the proposed modification, and the Examiner has failed to set for a *prima facie* case of obviousness. Moreover, Applicants note that the Examiner-proposed combination of the prior art would change the principle of operation of SCHULTZ. As such, Applicants respectfully submit the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Accordingly, for at least these reasons, Applicants respectfully request the Examiner withdraw the rejection of claims 41 - 47 and 60, and indicate claims 41 - 47 and 60 are allowable.

Independent Claim 62

Independent claim 62 recites:

A method for steeping barley, comprising:
at least one of:
 passing water through passageways in a floor of a container
with barley to be steeped, and
 passing gas through the passageways,
wherein a water and gas supply line system is located outside of
the container.

Initially, while independent claim 62 is indicated as rejected, Applicants submit the Examiner did not address any of the features of independent claim 62. The Examiner is respectfully reminded of the guidance provided by MPEP § 707.07(f) and MPEP § 2143.03, which are set forth above. Applicants respectfully submit the rejection of claim 62 is *per se* improper and the Examiner has failed to provide a complete action and a clear record, as discussed further below.

Additionally, Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art to combine HAMMER in view of SCHULTZ, and further in view of DEBLOIS and NUMBERGER, as there would no reasonable expectation of success for such a combination.

As noted above, in contrast to the present invention, which is directed to steeping barley, HAMMER is directed to a completely different technological field (i.e., hop extraction). Additionally, Applicants note that at least SCHULTZ and NUMBERGER are also directed to steeping barley. Moreover, Applicants note HAMMER provides no disclosure or teaching of using the HAMMER apparatus in other fields, such as, for example, steeping barely.

As such, Applicants submit the Examiner's combination of HAMMER SCHULTZ, DEBLOIS and NUMBERGER would not be obvious to one of ordinary skill in the art, as the HAMMER device operates in significantly different manner as compared to at least SCHULTZ and NUMBERGER, such that there would be no reasonable expectation of success with the Examiner-proposed combination.

Accordingly, for at least these reasons, Applicants respectfully request the Examiner withdraw the rejection of claim 62, and indicate claim 62 is allowable.

4. Over HAMMER in view of SCHULTZ, DEBLOIS and NUMBERGER and further in view of SAUVAGE

Applicants traverse the rejection of claim 58 under 35 U.S.C. § 103(a) as being unpatentable over HAMMER in view of SCHULTZ, DEBLOIS and NUMBERGER, and further in view of SAUVAGE. The rejection is respectfully traversed.

Initially, Applicants submit claim 58 depends from allowable independent claim 30, and is allowable based upon the allowability of independent claim 30, and because this claim recites additional subject matter to further define the instant invention.

Additionally, Applicants submit the combination of references do not teach or suggest each of the features of the presently claimed invention. Claim 58 recites, in pertinent part, “... wherein the water and CO₂ line systems are graduated.”

In addressing claim 58, the Examiner acknowledges that none of HAMMER, SCHULTZ, DEBLOIS and NUMBERGER teach or suggest water and CO₂ line systems being graduated. Applicants agree with the Examiner that none of HAMMER, SCHULTZ, DEBLOIS and NUMBERGER teach or suggest water and CO₂ line systems being graduated. However, the Examiner asserts SAUVAGE teaches “that the water (col. 1, lines 35 - 40) and CO₂ (col. 2, lines 25 - 42) line systems are graduated. Applicants respectfully disagree.

Applicants have reproduced the Examiner-cited portions of SAUVAGE below, which state:

It is currently sought, in such installations, to: decrease the consumption of water as much as possible, and for example to use less than 4.5 m³ of water per ton of malt; limit waste, for example cleaning products to be recycled, as much as possible; and obtain a completely cleanable installation; during the entire running, there should exist no zone where contaminating material could accumulate.

...

Another solution has therefore been envisaged, consisting in providing a vertically movable perforated platform, and in raising it only at the time of cleaning, this platform thus having, during normal operation, its usual height above the bottom of the tank. Thus, the height beneath the perforated platform is reduced to its minimum, which, during steeping, allows the usual characteristics of the process to be retained, in particular the CO₂ extraction rate (8 to 10 m³/s) and the flowrate of compressed air (180 to 200 mm head of water). This solution requires however the introduction beneath the platform of actuation means for raising it; these actuation means are then submerged in the steeping water and may constitute zones of accumulation of contaminating material which are hard to clean. It is moreover necessary to introduce a fluid beneath the perforated platform (electricity, compressed air, hydraulic fluid, etc.) in order to supply the aforementioned actuation means, which constitutes an additional drawback.

Applicants submit that the above passages of SAUVAGE (and the document in its entirety) are completely silent with regard to water and CO₂ line systems being graduated. As such, Applicants submit that none of HAMMER, SCHULTZ, DEBLOIS, NUMBERGER and SAUVAGE teach or suggest the features of claim 58, and no combination of HAMMER, SCHULTZ, DEBLOIS, NUMBERGER and SAUVAGE can render the presently claimed invention unpatentable.

Accordingly, for at least these reasons, Applicants respectfully request the Examiner withdraw the rejection of claim 58, and indicate claim 58 is allowable.

5. Over HAMMER in view of SCHULTZ, and further in view of SAUVAGE

Applicants traverse the rejection of claim 59 under 35 U.S.C. § 103(a) as being unpatentable over HAMMER in view of SCHULTZ, and further in view of SAUVAGE. The rejection is respectfully traversed.

Initially, Applicants submit claim 59 depends from allowable independent claim 30, and is allowable based upon the allowability of independent claim 30, and because this claim recites additional subject matter to further define the instant invention.

Additionally, Applicants submit the combination of references do not teach or suggest each of the features of the presently claimed invention. Claim 59 recites, in pertinent part, "... wherein the water and air line systems are graduated."

In addressing claim 59, the Examiner acknowledges that HAMMER does not teach or suggest water and air line systems being graduated. Applicants agree with the Examiner that HAMMER does not teach or suggest water and air line systems being graduated. However, the Examiner asserts SCHULTZ "discloses that the air line loading is closely controlled (col. 2, lines 6 - 15) which results in an ability to control the water level" and SAUVAGE discloses "that the water (col. 1, lines 35 - 40) system is graduated. Applicants respectfully disagree.

As noted above, with regard to claim 58, Applicants submit SAUVAGE does not teach or suggest water line systems being graduated. In fact, Applicants submit that the above passages of SAUVAGE (and the document in its entirety) are completely silent with regard to water line systems being graduated. Additionally, Applicants submit that even if SCHULTZ "discloses that the air line loading is closely controlled (col. 2, lines 6 - 15) which results in an ability to control the water level," as the Examiner asserts (and Applicants do not concede), such a teaching is not a teaching or suggestion of air line systems being graduated.

As such, Applicants submit that none of HAMMER, SCHULTZ and SAUVAGE teach or suggest the features of claim 59, and no combination of HAMMER, SCHULTZ and SAUVAGE can render the presently claimed invention unpatentable.

Accordingly, for at least these reasons, Applicants respectfully request the Examiner withdraw the rejection of claim 59, and indicate claim 59 is allowable.

Complete Action Not Provided

Applicants respectfully submit that the Examiner did not address each of the features of claim 35 and did not address any of the features of claims 31, 37, 42 - 47 and 60 - 62, as noted above. Thus, Applicants respectfully submit that the Examiner has not set forth a complete action or a clear record.

For at least these reasons, Applicants submit that a clear issue was not developed between the Examiner and Applicants. More specifically, MPEP §706 states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicants respectfully request that the Examiner properly address the untreated features of the claimed invention, such that a clear issue is developed between the Examiner and Applicant. Moreover, Applicants respectfully submit that the next action, which should clarify the record, should not be a final action.

CONCLUSION

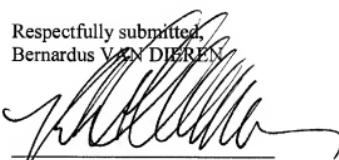
In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as recited in claims 30 - 62. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all of the claims therein are respectfully requested and now believed to be appropriate.

Authorization is hereby given to charge any fees necessary for the consideration of this amendment to deposit account No. 19-0089.

Should the Examiner have any further comments or questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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